

## REMARKS

### INTRODUCTION:

In accordance with the foregoing, claims 4, 5, 13 and 14 have been amended. No claims have been canceled or added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 4, 5, 7, 8, 13 and 14 are pending and under consideration. Reconsideration is respectfully requested.

### CLAIM OBJECTIONS:

In the Office Action, at page 3, claims 4 and 14 were objected to. Specifically, the Office Action states:

[T]he preamble of each claim is deemed to be inappropriate. The examiner notes the body of each claim seems to [be] direct[ed] to a system rather than simply an image apparatus.

Claims 4 and 14 have been amended and are now believed to be in condition for allowance. The Applicants respectfully submit that support for this amendment is inherent in claim 4, as originally filed.

### REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 3, claim 8 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,987,591, issued to Jyumonji et al. The Applicants respectfully traverse this rejection because Jyumonji fails to teach or suggest:

displaying the converted image data on a teaching pendant used for generating or editing a robot program or used for operating said robot,

wherein said displaying displays the image data and indication for manipulation for image processing simultaneously, or allows a user to enter a switching mode or a superposition mode.

According to a feature of the present invention, a (single) portable teaching pendant is connected to a robot controller, and the teaching pendant is used for (1) robot operating and also used for (2) image processing.

In Jyumonji, a teaching control panel TP shown in FIG. 11 is used for robot operating.

Jyumonji, col. 12, lines 52-60. However, in Jyumonji, a control panel for image processing is not such a teaching control panel TP, but a console 211 as shown in FIG. 4 and as described in column 6, lines 51 to 55. Thus, in Jyumonji, the teaching control panel TP is used for robot operating, not for image processing, and the console 211 is used for image processing, not for robot operating.

Additionally, the Applicants respectfully maintain that Jyumonji fails to teach or suggest a displaying operation wherein image data and indication for manipulation for image processing are displayed simultaneously, or that allows a user to enter a switching mode or superposition mode. While the Applicants concede that Jyumonji mentions cursor being displayed on a display, the Applicants respectfully submit that the claimed indication feature is not suggested. Specifically, the Applicants respectfully submit that the cursor mentioned in Jyumonji does not equate to an indication for manipulation for image processing.

The Applicants respectfully submit that since Jyumonji fails to teach or suggest all of the features of claim 8, claim 8 is allowable over Jyumonji. Accordingly, withdrawal of the § 102(e) rejection is respectfully requested.

#### REJECTION OF CLAIMS 4, 5, 7, AND 13 UNDER 35 U.S.C. §103:

In the Office Action, at page 5, claims 4, 5, 7 and 13<sup>2</sup> were rejected under 35 U.S.C. §103(a) as being unpatentable over Jyumonji. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is respectfully requested.

Regarding claim 4, the Applicants respectfully submit that, in at least two respects, the rejection fails to establish a prima facie case of obviousness. First, the Applicants respectfully submit that the reference fails to teach or suggest all of the claimed features. Second, the Applicants respectfully submit that Office Action fails to provide a valid line of reasoning from the prior art motivating the Examiner's proposed modification of the reference.

To establish a prima facie case of obviousness, three basic criteria must be met. MPEP §2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Id. Second, there must be a reasonable expectation of

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<sup>2</sup> The Office Action actually mentions claims "4-5, 7 and 14." However, it seems clear from the substance of the Office Action, and also from the separate treatment of claim 14 later in the same Office Action, that

success. Id. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Id. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Id.

As admitted by the Examiner, Jyumonji fails to teach or suggest:

    said teaching pendant comprises a unit for generating or editing a robot program, a unit for operating the robot, and a display unit, and can display on the display unit the converted image, and comprises a unit used for manipulation for image processing.

Further, as discussed above with respect to claim 8, Jyumonji cannot be relied upon for teaching or suggesting:

    said display unit displays, indication for generating or editing of the robot a program and indication for manipulation of image processing, together with an image simultaneously, or allows a user to select either a switching mode or a superposition mode.

Accordingly, the Applicants respectfully submit that Examiner's *prima facie* case of obviousness is deficient because it does not teach or suggest all of the features of claim 4.

Additionally, the Applicants respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art motivating the Examiner's proposed modification of the reference. Rather, the Office Action states on page 6:

    At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to recognize it is [a] functional equivalent to have [an] image processor incorporated in the teaching control panel or incorporated in [a] robot controller, which the teaching control panel is connected to through an interface. And a person of ordinary skill in the art would have been motivated to modify Jyumonji's system to have the image processor incorporated in the teaching control panel because it increases system image processing speed by eliminating the transmission delay between the teaching control panel and the image processor.

The Applicant's respectfully submit that, at best, this amounts to an improper hindsight reconstruction of the invention. Accordingly, the Applicants request withdrawal of the §103(a) rejection.

Regarding claim 5, 7 and 13, these claims depend directly from independent claim 4 and

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claim 13 was intended. The Applicants have prepared this response based on this assumption.

are therefore believed to be allowable for at least the reasons noted above.

REJECTION OF CLAIM 14 UNDER 35 U.S.C. §103:

In the Office Action, at page 7, claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Jyumonji in view of U.S. Patent No. 6,362,813 issued to Wörn et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is respectfully requested.

The Examiner states at page 7:

The arguments in paragraph 11 above as to the applicability of Jyumonji are incorporated herein.

With regard to Claim 14, the only unaddressed limitation is "a display unit can display an image processing manipulation menu."

However, as discussed above with respect to claim 8, Jyumonji does not teach or suggest a display displaying an indication for manipulation of image processing, together with image of the robot simultaneously. The Applicants respectfully submit that Wörn fails to make up for this deficiency. Accordingly, the applicants respectfully submit that the proposed combination of Jyumonji and Wörn cannot be relied upon for teaching or suggesting:

said display unit displays an indication for generating or editing of the robot program and an indication for manipulation of image processing, together with the gray scale or color scale visual image of the robot simultaneously and allows a user to select between using the pendant for image processing teaching and robot teaching/control.

The Applicants also respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art suggesting the Examiner's proposed combination of the references. Rather, the Office Action states on page 7:

At the time the invention was made, it would be reasonable for a person of ordinary skill... in the art to assume that the computer controls the robot contains an image processing manipulation menu, which in Wörn will be displayed on the programming device.

And a person of ordinary skill... in the art would be motivated to incorporate... such functionality into Jyumonji's teaching control panel because Wörn teaches it is desirable to have more extensive display possibilities on a portable control panel, column 1, line 60.

The Applicant's respectfully submit that this also amounts to an improper hindsight reconstruction of the invention, at best. Accordingly, the Applicants respectfully request

withdrawal of the §103(a) rejection.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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